

(ii) Study on Substantive and Procedural Requirements Regarding Voluntary Division of Patent Applications by Applicants.

- In addition to the requirements regarding the voluntary division of patent applications by applicants, the inputs may include issues relating to the prohibition of double patenting and any other relevant information.

■ Requirements for Division of Patent Application

1. Overview

Article 44 of the Patent Act, which covers the division of patent applications. This article stipulates that the applicant may make part of a patent application containing two or more inventions a new patent application. And, this article stipulates that, if a patent application is lawfully divided, the new application is deemed to have been filed at the same time as the original application.

2. Requirements for and Effect of Division of a Patent Application

2.1 Formal requirements for the division of a patent application

2.1.1 Person entitled to divide a patent application

Entitled to divide a patent application is the applicant thereof (Article 44(1)). In other words, the applicant of the original application and that of the divisional application must be the same at the time of division

2.1.2 When the division of a patent application is allowed

A patent application may be divided at any of the timings set forth in (i) to (iii) below.

- (i) During the time period in which amendments to the description, claims, or drawings (In this chapter, hereinafter, referred to as "description, etc.") are allowed (Article 44(1)(i)) (Note 1)
- (ii) Within 30 days from transmittal of a certified copy of a decision to grant a patent (Note 2) (Article 44(1)(ii)) (Notes 3 to 5)
- (iii) Within three months from transmittal of a certified copy of the non-final decision of refusal (Note 6) (Article 44(1)(iii)) (Notes 4 and 5)

(Note 1) The applicant may amend the description, etc. in any of the following timing (i) to (v) (Article 17bis(1)).

- (i) After the application before the transmittal of a certified copy of an examiner's decision that a patent is to be granted (except after the applicant receives the first notice of reasons for refusal) (Article 17bis(1))
- (ii) Within the designated time limit of a non-final notice of reasons for refusal (Article 17bis(1)(i))
- (iii) Within the designated time limit of a notice under Article 48septies after receiving a notice of reasons for refusal (Article 17bis(1)(ii))

- (iv) Within the designated time limit of a final notice of reasons for refusal (Article 17bis(1)(iii))
- (v) At the same time when a request is made for an appeal against an examiner's decision of refusal (Article 17bis(1)(iv))

(Note 2) The following cases are excluded.

- (a) If a decision to grant a patent is given upon reconsideration by examiners before appeal proceedings (Article 51 as applied mutatis mutandis in Article 163(3)).
- (b) If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and a decision to grant a patent is given (Articles 160(1) and 51).

(Note 3) Even before 30 days have passed from the date of transmittal of a certified copy of a decision to grant a patent, once the registration of the patent right is established, the application may not be divided as it is no longer pending at the Patent Office.

(Note 4) A decision in an appeal against the examiner's decision of refusal is not a decision to either grant or refuse a patent, so the time periods set forth in (ii) and (iii) above do not include the time period following the transmittal of a certified copy of the appeal decision.

(Note 5) The time periods set forth in (ii) and (iii) above may be extended or otherwise changed (Article 44 (5) to (7)).

(Note 6) The following cases are excluded.

- If a decision of refusal is cancelled by an appeal against the examiner's decision of refusal and is referred back by an appeal decision for re-examination, and another decision of refusal is given (Articles 160(1) and 49).

2.2 Substantive requirements for the division of a patent application

The division of a patent application is to make part of a patent application containing two or more inventions a new patent application; therefore, Requirements 1 and 3 below must be met. Moreover, given the effect of division, that is, the divisional application being deemed to have been filed at the same time as the original application, Requirement 2 below must also be satisfied.

(Requirement 1) All of the inventions stated in the description, etc., as they stand immediately prior to the division of the original application do not together constitute the

invention claimed in the divisional application.

(Requirement 2) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stood at the time of filing thereof.

(Requirement 3) The matters stated in the description, etc., of the divisional application are within the scope of those stated in the description, etc., of the original application as they stand immediately prior to the division thereof.

However, if a patent application is divided during the time period in which amendments to the description, etc., of the original application are allowed (Note), then Requirement 3 shall be deemed satisfied so long as Requirement 2 is met. This is because a matter which is not stated in the description, etc., of the original application as it stands immediately prior to the division thereof but was stated in the description, etc., of the original application as it stood at the time of filing thereof, may be included by an amendment in the description, etc., of the original application before it is divided.

■ Notification under Article 50bis

Article 50bis of the Patent Act provides for notification by the examiner in the examination of a divisional application and related matters. It stipulates that if the examiner is to give notice of reasons for refusal of a patent application and such reasons are the same as those for refusal of the original application, etc., then the examiner must include a statement to that effect.

The objective of the provision of Article 50bis (and Article 17bis(5)) is to encourage the applicant to fully scrutinize the reasons for refusal notified in the examination of the original application, etc., and refrain from dividing the application for the invention for which such reasons were already notified, without resolving such reasons.

If notification pursuant to the provision of Article 50bis (In this section, hereinafter, referred to as "Article 50bis notification.") is given together with a notice of reasons for refusal with respect to a patent application and the description, etc., are to be amended, then such amendment must meet the requirements prescribed in paragraphs 3 to 6 of Article 17bis, just as amendments after the final notice of reasons for refusal are required to do so. Amendments that do not satisfy such requirements are dismissed.

For the sake of clarity, in the cases described in (i), (ii) below, the examiner shall be careful not to apply the provision of Article 50bis more formally than necessary.

- (i) It is not clear whether the reasons for refusal at issue are the same as those stated in a notice of reasons for refusal of another patent application (e.g., reasons for refusal cannot be clearly identified from statements in a notice of reasons for refusal of another patent application).
- (ii) The reasons for refusal relate to errors or other minor improper in statements.

■ Relation to the Prohibition Rule of Double Patenting (Article 39)

If a divisional application is identical to the original application, it will be treated as having been filed

on the same date. If the original application is withdrawn, the divisional application will remain valid. Additionally, if an application is abandoned, withdrawn, dismissed, or refused (a decision of refusal or a trial decision of refusal is determined), it will lose its status as a prior application (as per Article 39(5)). Therefore, if the original application is withdrawn or receives a decision of refusal, the divisional application will not receive a decision of refusal based on the identity of the two applications.

■ Relevant Provisions

(Prior application)

Article 39(1)

Where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed.

(2) Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who has been selected by consultations between the applicants who filed said applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.

(3) Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.

(4) Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.

(5) Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to said patent application.

(6) The Commissioner of the Patent Office shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result

thereof, while designating an adequate time limit.

(7) Where no report under the preceding paragraph is submitted within the time limited designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) or (4) has been reached.

(Division of Patent Applications)

Article 44

An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions only within the following time limits:

(i) at such time when or within such time period in which amendments of the description, scope of claims or drawings attached to the request are allowed;

(ii) within 30 days from the date of service of a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied mutatis mutandis under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160(1)); and

(iii) within three months from the date of service of a certified copy of the examiner's initial decision to the effect that the application is to be refused.

(2) In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original patent application; provided, however, that this shall not apply for the purposes of application of these provisions and the provision of Article 30(3) in the case where the new patent application constitutes another patent application as prescribed in Article 29bis or a patent application as prescribed in Article 3bis of the Utility Model Act.

(3) For the purpose of application of Article 43(2) (including the cases where it is applied mutatis mutandis in Article 43bis(2) (including the case where it is applied mutatis mutandis in paragraph 3 of the preceding Article) and in paragraph 3 of the preceding Article) in the case where a new patent application is filed under paragraph 1, "within one year and four months from the earliest of the following dates" in Article 43(2) shall be deemed to be replaced with "within one year and four months from the earliest of the following dates or three months from the date of filing of the new patent application, whichever is later."

(4) Where a new patent application is filed under paragraph 1, any statements or documents which have been submitted in relation to the original patent application (in the case of a submission under Article 43(2) (including the cases where it is applied mutatis mutandis pursuant to Article 43bis(2) (including the case where it is applied mutatis mutandis pursuant to paragraph (3) of the preceding Article; hereinafter the same shall apply in this paragraph) and paragraph (3) of the preceding Article), including statements or documents provided by electronic or magnetic means) and are required to be submitted in relation to the new patent application under Article 30(3), 41(4), or 43(1) and 43(2) (including the cases where these provisions are applied mutatis mutandis in Article 43bis(2) and in paragraph 3 of the preceding Article) shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with such new patent application.

(5) If the period as provided in Article 108(1) is extended under Article 4 or Article 108(3), the 30-day period as provided in paragraph (1)(ii) shall be deemed to have been extended only for that period as extended.

(6) If the period as provided in Article 121(1) is extended under Article 4, the three-month period as provided in paragraph (1)(iii) shall be deemed to have been extended only for that period as extended.

(7) If the applicant of a new patent application as provided in paragraph 1 cannot file such new application within the time period provided in item (ii) or (iii) of the same paragraph due to a reason not attributable to the applicant, then, notwithstanding these provisions, the applicant may file such new application within 14 days (or two months, if the applicant is a resident abroad) from the day when such reason ceases to exist, but no later than six months from the expiry of the time period provided in these provisions.

(Notice to the effect that the reasons for refusal stated therein are the same as those stated in a preceding notice)

Article 50-2

In the case where the examiner intends to give a notice of reasons for refusal for a patent application under the preceding Article, if such reasons for refusal are the same as those stated in a notice given under the preceding Article (including the cases in which it is applied mutatis mutandis in Article 159(2) (including the case in which it is applied mutatis mutandis in Article 174(2) and in Article 163(2)) in connection with another patent application (limited to one that is deemed to have been filed simultaneously with the application concerned by virtue of the application of the provision of Article 44(2) to at least either of the application concerned and such other application) (except where the contents of such notice were not accessible to the applicant of the application concerned prior to the filing of a request for examination thereof), then the examiner shall also give a notice to that effect.

■ References

· Examination Guidelines for Patent and Utility Model in Japan

Part III Chapter 4 Prior Application (Patent Act Article 39)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0400_e.pdf

Part IV Chapter 1 Requirements for Amendments (Patent Act Article 17bis)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/04_0100_e.pdf

Part VI Chapter 1 Division of Patent Application

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/06_0101_e.pdf

· Examination Handbook for Patent and Utility Model in Japan

Part III Chapter 4 Prior Application (Patent Act Article 39)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/handbook_shinsa/document/index/03_e.pdf#page=60

Part IV Chapter 1 Requirements for Amendments (Patent Act Article 17bis)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/handbook_shinsa/document/index/04_e.pdf#page=2

Part VI Chapter 1 Division of Patent Application

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/handbook_shinsa/document/index/06_e.pdf#page=3